opl. No.:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Eva Maria Lanig et al.

09/902,349

Conf. No.:

8888

Filed:

July 10, 2001

Title:

METHOD AND APPARATUS FOR TRANSMITTING VOICE INFORMATION IN A

MOBILE RADIO NETWORK

Art Unit:

2642

Examiner:

Thjuan P. Knowlin

Docket No.:

112740-259

Mail Stop

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

CERTIFICATE OF MAILING BY FIRST CLASS MAIL UNDER 37 CFR 1.8

Sir:

I hereby certify that the following documents relating to the above-identified application:

- 1. Transmittal of Appeal Brief in triplicate;
- 2. Appeal Brief in triplicate;
- 3. Appendix A Pending Claims on 3 pages;
- 4. Appendix B Final Office Action on 7 pages;
- 5. Appendix C U.S. Patent 5,608,779 on 17 pages;
- 6. check in the amount of \$500.00; and
- 7. return receipt postcard.

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

on November 16, 2005.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

Heather Foster

Name of Person Mailing Correspondence

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NOV.		Docket No. 112740-259								
-4		Of: Eva Maria Lanig	g et al.							
Application No		Filing Date July 10, 2001	Examiner Thjuan P. Knowlin	Customer No. 29177	Group Art Unit 2642	Confirmation No. 8888				
Invention: METHOD AND APPARATUS FOR TRANSMITTING VOICE INFORMATION IN A MOBILE RADIO NETWORK										
COMMISSIONER FOR PATENTS:										
Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on										
The fee for filing this Appeal Brief is: \$500.00										
☑ A check in the amount of the fee is enclosed.										
☐ The Director has already been authorized to charge fees in this application to a Deposit Account.										
The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 02-1818										
	☐ Payment by credit card. Form PTO-2038 is attached.									
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.										
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Signature of Person Mailing Correspondence

Heather Foster

cc:

Typed or Printed Name of Person Mailing Correspondence

Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on

November 16, 2005



Appellants:

Eva Maria Lanig et al

Appl. No.:

09/902,349

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METHOD AND APPARATUS FOR TRANSMITTING VOICE

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Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Appellants submit this Appeal Brief in support of the Notice of Appeal filed on September 16, 2005. This Appeal is taken from the Final Rejection dated June 16, 2005, which is attached as Appendix B.

I. REAL PARTY IN INTEREST

The real party in interest for the above-identified patent application on appeal is Siemens Aktiengesellschaft, by virtue of an Assignment dated August 17, 1999 and recorded at the United States Patent and Trademark Office at reel 12430, frame 635-637.

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II. RELATED APPEALS AND INTERFERENCES

Appellants, Appellant's legal representative and the Assignee of the above-identified patent application do not know of any prior or pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision with respect to the above-identified Appeal.

III. STATUS OF CLAIMS

Claims 1-11 are pending in the above-identified patent application, with claims 1, 8 and 11 being independent claims. Claims 1-11 stand rejected. Accordingly, Claims 1-11 are being appealed in this Brief. A copy of the appealed claims is attached as Appendix A.

IV. STATUS OF AMENDMENTS

No amendments were made in this application after the final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present claims generally relate to an apparatus and method for transmitting voice information through the core network of a mobile radio network, between connected core networks of mobile radio networks, and from mobile radio networks to wire-bound users of a PSTN (specification page 1, lines 7-10). Specifically, the claims recite a processing apparatus and a transmitting apparatus, where an event, such as a planned conference, announcement, interception, etc., triggers a conversion of bits of voice information in the mobile radio network into a transcoded format. The converted bits are further processed to incorporate the event into the voice information data. Using the example provided above, voice data of conference partners may be mixed for a planned conference, announcements may be mixed with bits of voice information for playing announcements, voice data for an interception may be duplicated and mixed, and so on (specification, page 3, line 29 – page 4, line 6). Once the bits are processed to incorporate the event into the voice information data, they are subsequently converted into a non-transcoded format and transmitted (specification page 4, lines 6-8).

Although specification citations are given in accordance with C.F.R. 1.192(c), these reference numerals and citations are merely examples of where support may be found in the specification for the terms used in this section of the Brief. There is no intention to suggest in any way that the terms of the claims are limited to the examples in the specification. As demonstrated by the references numerals and citations below, the claims are fully supported by the specification as required by law. However, it is improper under the law to read limitations from the specification into the claims. Pointing out specification support for the claim terminology as is done here to comply with rule 1.192(c) does not in any way limit the scope of the claims to those examples from which they find support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In short, the references numerals and specification citations are not to be construed as claim limitations or in any way used to limit the scope of the claims.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-11 stand rejected under 35 U.S.C. §102(b) as being anticipated by Lev et al. (U.S. Patent No. 5,608,779). A copy of Lev is attached as Appendix C.

VII. ARGUMENT

A. LEGAL STANDARDS

1. Anticipation under 35 U.S.C. §102

Anticipation is a factual determination that "...requires the presence in a single prior art disclosure of each and every element of a claimed invention." *Lewmar Marine, Inc. v. Barient, Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Moreover, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference." *Verdegaal Bros. v. Union Oil of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (*emphasis added*).

Federal Circuit decisions have repeatedly emphasized the notion that anticipation cannot be found where less than <u>all</u> elements of a claimed invention are set forth in a reference. *See, e.g. Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364 (Fed. Cir. 2002). In this regard, a reference disclosing "substantially the same thing" is not enough to anticipate. *Jamesbury Corp. v. Litton Indust. Prod., Inc.*, 756 F.2d 1556, 1560 (Fed. Cir. 1985). A reference must clearly disclose each and every limitation of the claimed invention before anticipation may be found.

Further, anticipation cannot be shown by combining more than one reference to show the elements of the claimed invention. *In re Saunders*, 444 F.2d 599 (C.C.P.A. 1971). All elements of a claimed invention must be disclosed in one, solitary reference. As such, it is clear that a reference cannot be utilized to render a claimed invention anticipated without identical disclosure.

B. THE REJECTION UNDER 35 U.S.C. §102(B) IS IMPROPER BECAUSE LEV ET AL. DOES NOT ANTICIPATE THE CLAIMED INVENTION

In the Final Office Action, Claims 1-11 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Lev et al.* (US Patent 5,608,779). Appellants submit this rejection is improper and should be reversed.

Specifically, *Lev* does not teach "converting the voice information, dependent on an event, in the mobile radio network into a transcoded format; processing the voice information further to incorporate the event into voice information data; and converting the voice information into a non-transcoded format" as recited in claim 1, and similarly recited in claims 8 and 11.

Lev discloses a GSM architecture where external transcoding equipment (121-123) transmits PCM coded speech data between switches (col. 3, lines 45-62). Lev teaches that the switching center and the transcoders communicate in a non-compressed format, while the mobile units transceive information in the form of compressed digital voice (col. 3, lines 45-62). Depending on the operating mode (transcoding, transparent), the site controller or switching center knows to convert compressed data to non-compressed data, and vice-versa (col. 5, lines 13-43). However, Lev does not disclose processing the voice information further to incorporate the event into voice information data, and converting the voice information into a non-transcoded format. While the Office Action has interpreted "event" in Lev as meaning operating mode, this interpretation does not match the features recited in the present claims. As the present claims require incorporating/importing of the event into the voice data itself, this feature is not taught nor suggested by Lev. It is noted that, in this regard, claim 11 (see also claim 2), recites that the event features are further defined as a request for importing announcement data, tone data or other data into the transmitted voice information. These features are clearly not taught nor suggested by Lev.

Regarding the Examiner's Response to Arguments, contained in the Final Office Action, the Examiner alleged that *Lev* disclosed processing the voice information to incorporate the event into voice information data (col. 1, lines 15-27, col. 5, lines 44-55 and col. 6, lines 18-30); and converting the voice information into a non-transcoded format (col. 3, lines 45-62 and col. 5, lines 13-43). Applicants submit that upon closer examination, the passages disclose nothing of

the sort, and merely describe the conversion-operation of the transcoders depending on the operating mode, discussed above. *Lev* explicitly teaches that the switching center (101) determines when calls originated by mobile units (116-117) are intended for other mobile units (116-117) to control the operating mode of the transcoders (121-123). When a mobile-to-mobile call is detected, the required transcoders (121-123) are instructed to operate in a transparent mode, and compressed digital audio is essentially passed through the transcoders without conversion, thereby eliminating double format conversions. When necessary, the transcoders (121-123) can also operate in a transcoding mode (i.e., compressed digital audio is converted in to non-compressed digital audio and vice versa) (col. 4, lines 11-22). The passages cited in the Response to Arguments merely details a mobile-to-mobile embodiment, where the switching center (101) instructs a transcoder to pass compressed or non-compressed signals, depending on the target unit and detected operating mode.

For the reasons discussed above, *Lev* fails to teach, suggest, or even disclose all the elements in the present claims, and thus, fails to anticipate the present claims. Accordingly, Appellants respectfully submit that claims 1-11 are in condition for allowance.

VIII. CONCLUSION

Appellants respectfully submit that claims 1-11 are not anticipated and non-obvious in view of the cited art. Accordingly, Appellants respectfully submit that the rejection of pending claims 1-11 is erroneous in law and fact and should be reversed by this Board.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

Deter 7um

Reg. No. 48,196

Customer No.: 29177 Phone: (312) 807-4208

Dated: November 16, 2005

APPENDIX A

PENDING CLAIMS ON APPEAL OF U.S. PATENT APPLICATION SERIAL NO. 09/902,349

Claim 1. (previously presented): A method for transmitting voice information through a mobile radio network, the method comprising the steps of:

converting the voice information, dependent on an event, in the mobile radio network into a transcoded format;

processing the voice information to incorporate event into voice information data; converting the voice information into a non-transcoded format; and transmitting the voice information in the non-transcoded format.

Claim 2. (previously presented): A method for transmitting voice information through a mobile radio network as claimed in claim 1, wherein the event is an intended importing of one of announcements, tones, and other information into a conversation represented by the transmitted voice information, wherein the step of processing includes importing the one of announcements, tones, and other information into the conversation by a mixing device, and wherein the step of transmitting includes transmission in a core network of the mobile radio network.

- Claim 3. (previously presented): A method for transmitting voice information through a mobile radio network as claimed in claim 1, wherein the event is one of an intended handover in the mobile radio network, and an intended handover to another mobile radio network.
- Claim 4. (previously presented): A method for transmitting voice information through a mobile radio network as claimed in claim 1, wherein the event is an intended duplication of the voice information for a legal tapping process.

Claim 5. (previously presented): A method for transmitting voice information through a mobile radio network as claimed in claim 1, wherein the step of transmitting occurs from a radio network controller to one of another radio network controller of the mobile radio network and a gateway into another network.

Claim 6. (previously presented): A method for transmitting voice information through a mobile radio network as claimed in claim 1, wherein the conversions are initiated by a feeding device in a media gateway of the mobile radio network.

Claim 7. (previously presented): A method for transmitting voice information through a mobile radio network as claimed in claim 3, wherein, in the case of the event being a handover in the mobile radio network, co-heard user plane information is handed over to a new radio network controller that is not yet actively switched in order to enable an interruption-free changeover during the handover.

Claim 8. (previously presented): An apparatus for transmitting voice information through a mobile radio network, comprising:

a conversion device;

a part for processing; and

a transmission part;

wherein the voice information, dependent on an event, is converted via the conversion device into a transcoded format, is further processed via the part for processing, is again converted in the conversion device into a non-transcoded format, and is transmitted by the transmission part, in the non-transcoded format, via an interface to one of another media gateway and switch.

Claim 9. (previously presented): An apparatus for transmitting voice information through a mobile radio network as claimed in claim 8, wherein the apparatus includes a media gateway.

Claim 10. (previously presented): An apparatus for transmitting voice information through a 30 mobile radio network as claimed in claim 8, further comprising one of a mixing device and a driving part for driving the mixing device for mixing the voice information in the transcoded format with one of announcements, tones and other information.

Claim 11. (previously presented): A method for transmitting voice information through a mobile radio network, the method comprising the steps of:

detecting if there is a request for importing announcement data, tone data or other data into the transmitted voice information;

converting the voice information in the mobile radio network into a transcoded format when said request is detected;

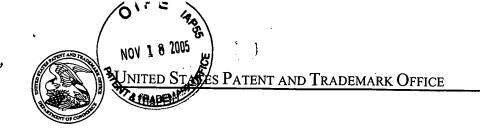
processing the voice information and importing the requested data into the conversation by a mixing device;

converting the voice information into a non-transcoded format; and

transmitting the voice information in the non-transcoded format through a core network of the mobile radio network.

APPENDIX B

Final Office Action Mailed on June 16, 2005



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/902,349	07/10/2001	Eva Maria Lanig	112740-259	8888	
29177 75	590 06/16/2005		EXAM	EXAMINER	
BELL, BOYD P. O. BOX 113:	0 & LLOYD, LLC 5		KNOWLIN, THJUAN P		
CHICAGO, IL	60690-1135		ART UNIT	PAPER NUMBER	
			2642		
			D		

DATE MAILED: 06/16/2005

DUE: 9/16/05

Please find below and/or attached an Office communication concerning this application or proceeding.

BELL BOYD & LOYD INTELLECTUAL PROSTATIVE DE LA CONTRACTIVE DEL CONTRACTIVE DE LA CON

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ATTY: PAK / PZZ DOCKET #: 112740-259

OPE W.								
(S)	Application No.	Applicant(s)						
NOV 1 8 2005	09/902,349	LANIG ET AL.	•					
Office Action Summary	Examiner	Art Unit						
THE FRANCE PROPERTY.	Thjuan P. Knowlin	2642						
The MAILING DATE of this communication Period for Reply	on appears on the cover sheet w	with the correspondence address						
A SHORTENED STATUTORY PERIOD FOR A THE MAILING DATE OF THIS COMMUNICAT - Extensions of time may be available under the provisions of 37 of after SIX (6) MONTHS from the mailing date of this communicated. If the period for reply specified above is less than thirty (30) days of the time of time of time of the time of	TION. CFR 1.136(a). In no event, however, may a tion. s, a reply within the statutory minimum of the period will apply and will expire SIX (6) MC y statute, cause the application to become A	reply be timely filed irty (30) days will be considered timely. NTHS from the mailing date of this communication ABANDONED (35 U.S.C.§ 133).	on.					
Status								
1) Responsive to communication(s) filed on	<u>10 February 2005</u> .							
,, -	This action is non-final.							
3) Since this application is in condition for a	•	• •	S					
closed in accordance with the practice un	nder <i>Ex par</i> te Quayle, 1935 C.	D. 11, 453 O.G. 213.						
Disposition of Claims								
4)⊠ Claim(s) <u>1-11</u> is/are pending in the applic	cation.							
4a) Of the above claim(s) is/are wi	thdrawn from consideration.							
5) Claim(s) is/are allowed.								
6)⊠ Claim(s) <u>1-11</u> is/are rejected.								
7) Claim(s) is/are objected to.								
8) Claim(s) are subject to restriction	and/or election requirement.							
Application Papers								
9)☐ The specification is objected to by the Exa	aminer.							
10) The drawing(s) filed on 10 February 2005	is/are: a)⊠ accepted or b)□	objected to by the Examiner.						
Applicant may not request that any objection	to the drawing(s) be held in abeya	nce. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including the o	Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).							
11)☐ The oath or declaration is objected to by t	he Examiner. Note the attache	d Office Action or form PTO-152.						
Priority under 35 U.S.C. § 119	•							
12) Acknowledgment is made of a claim for for a) All b) Some * c) None of: 1. Certified copies of the priority docu 2. Certified copies of the priority docu 3. Copies of the certified copies of the	ments have been received. ments have been received in A	Application No						
application from the International B	•	·						
* See the attached detailed Office action for		received.						
Attachment(s)								
1) Notice of References Cited (PTO-892)	4) Interview	Summary (PTO-413)						
2) 🔲 Notice of Draftsperson's Patent Drawing Review (PTO-94	8) Paper No(s)/Mail Date						
 Information Disclosure Statement(s) (PTO-1449 or PTO/S Paper No(s)/Mail Date 	SB/08) 5) Notice of I 6) Other:	nformal Patent Application (PTO-152) —						

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DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on February 10, 2005 has been entered. Claims 1-10 have been amended. No claims have been cancelled. Claim 11 has been added. Claims 1-11 are now pending in this application, with claims 1, 8, and 11 being independent.

Claim Rejections - 35 USC § 102

- 2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- 3. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lev et al (US 5,608,779).
- 4. In regards to claims 1 and 11, Lev discloses a method for transmitting voice information through a mobile radio network (Fig. 2 and communication system 100), the method comprising the steps of: converting the voice information, dependent on an event, in the mobile radio network into a transcoded format (See Abstract); processing the voice information to incorporate event into voice information data (col. 1 lines 15-27, col. 5 lines 13-26, col. 5 lines 44-55, and col. 6 lines 18-30); converting the voice information into a non-transcoded format; and transmitting the voice information in the non-transcoded format (col. 3 lines 45-62 and col. 5 lines 13-43).

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- 5. In regards to claims 2 and 10, Lev discloses a method for transmitting voice information through a mobile radio network, wherein the event is an intended importing of one of announcements, tones, and other information into a conversation represented by the transmitted voice information, wherein the step of processing includes importing the one of announcements, tones, and other of information into the conversation by a mixing device (conference bridge), and wherein the step of transmitting includes transmission in a core network of the mobile radio network (col. 6 lines 18-25, col. 10-11 lines 64-22, and col. 7-8 lines 54-7).
- 6. In regards to claims 3 and 4, Lev discloses a method for transmitting voice information through a mobile radio network, wherein the event is one of an intended handover in the mobile radio network, and an intended handover to another mobile radio network (col. 10 lines 29-57).
- 7. In regards to claims 5 and 7, Lev discloses a method for transmitting voice information through a mobile radio network, wherein the step of transmitting occurs from a radio network controller (first site controller 206) to one of another radio network controller (second site controller 207) of the mobile radio network and a gateway into another network (col. 10 lines 14-28).
- 8. In regards to claim 6, Lev discloses a method for transmitting voice information through a mobile radio network, wherein the conversions are initiated by a feeding device in a media gateway of the mobile radio network (col. 4 lines 11-28 and col. 5 lines 27-55).

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9. In regards to claims 8 and 9, Lev discloses an apparatus for transmitting voice information through a mobile radio network, comprising: a conversion device (transcoder 221); a part for processing; and a transmission part; wherein the voice information, dependent on an event, is converted via the conversion device into a transcoded format, is further processed via the part for processing, is again converted in the conversion device into a non-transcoded format (col. 3 lines 45-62 and col. 5 lines 13-43), and is transmitted by the transmission part, in the non-transcoded format, via an interface to one of another media gateway and switch (second switching center 202) (col. 10 lines 14-28).

Response to Arguments

10. Applicant's arguments filed 02/10/05 have been fully considered but they are not persuasive. Applicants argue that Lev does not teach "converting the voice information, dependent on an event, in the mobile radio network into a transcoded format; processing the voice information further to incorporate the event into voice information data; and converting the voice information into a non-transcoded format." Examiner respectfully disagrees with this argument. Lev does disclose converting the voice information, dependent on an event, in the mobile radio network (See Fig. 2 and communication system 100) into a transcoded format (See Abstract); processing the voice information further to incorporate the event into voice information data (See col. 1 lines 15-27, col. 5 lines 13-26, col. 5 lines 44-55, and col. 6 lines 18-30); and converting

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the voice information into a non-transcoded format (See col. 3 lines 45-62 and col. 5 lines 13-43).

Conclusion

- 11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
- 12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
- 13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thjuan P. Knowlin whose telephone number is (571) 272-7486. The examiner can normally be reached on Mon-Fri 8:30-5:00pm.
- 14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thjuan P. Knowlin

BING Q. BUI PRIMARY EXAMINER

APPENDIX C

U.S. Patent No. 5,608,779 ("Lev et al.")